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01/12/2004

Kevin R. Pierce

8434

20606

7590

02/08/2006

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EXAMINER

HARRIS, ANTON B

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/755,839 | Applicant(s) PIERCE, KEVIN R. | |
| | Examiner Anton B. Harris | Art Unit 2831 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments, see pages 5-7, filed 07 November 2005, with respect to the rejection(s) of claim(s) 1 and 2 under 35 U.S.C. 103(a) have been fully considered and are persuasive. In response to Applicant's argument that the limitation of a center opening extending from the front side through the back side is not disclosed by the combination of the previously cited prior art references, the Examiner agrees. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hyde (6,376,770).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohnen (6,098,825) in view of Hyde.

Regarding claim 1, Kohnen (col. 5, line 55 – col. 6, line 67) discloses an adapter plate comprising:

top 31 and bottom 31 sides,

left 30A and right 30B sides extending between the top 31 and bottom 31 sides,

Art Unit: 2831

a back side 24 extending between the top 31, bottom 31 and left 30A and right 30B sides, and having a smooth curvature (back side of 38) complimentary to the curvature of the exposed face of the log P, a front side 41 extending between the top 31, bottom 31 and left 30A and right 30B sides, and having cover support zone, and (ii) substantially flat support zone pads 33 at opposite ends thereof, a generally rectangular center opening (covered by element 41 in figure 3), but lacks a flat generally surrounding cover support zone and a generally rectangular center opening extending from the front side through the back side, the center opening being sized to slidably receive the box therethrough.

Hyde (col. 6, lines 1-67) teaches a flat generally surrounding cover support zone 210 and a generally rectangular center opening 211 extending from the front side through the back side, the center opening 211 being sized to slidably receive the box 10 therethrough. See discussion in col. 6, line s 19-24.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Kohnen by providing a flat generally surrounding cover support zone and a generally rectangular center opening extending from the front side through the back side, the center opening being sized to slidably receive the box therethrough in order to secure the cover to the box in view of the teachings of Hyde.

Furthermore, the limitations of “for supporting engagement with the flat back side perimeter of the cover” and “for supporting engagement with the positioning tabs of the box” in claim 1 have been considered, but do not result in a structural difference. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed

Art Unit: 2831

does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 2, Kohnen (col. 5, line 55 – col. 6, line 67) discloses a method comprising:

providing an electrical box 22, an electrical component (col. 6, lines 14-20) having positioning tabs on opposite ends thereof,

a cover 41, and

an adapter plate comprising:

surrounding top 31, bottom 31, left 30A and right 30B sides,

a back side having a smooth curvature (back side of 38) complimentary to the curvature of the exposed face of the log P,

a front side 41, and substantially flat support zone pads 33 at opposite ends thereof for supporting engagement with the positioning tabs of the box 22, and a center opening (covered by element 41 in figure 3); forming an opening 36 sized to receive the electrical box (not shown) in the log through the curved exposed face P of the log;

securing the electrical box (not shown) and adapter plate to the curved exposed face P of the log with the electrical box (not shown) extending into the opening in the log P;

securing the positioning tabs of the electrical component to the zone pads 33 of the adapter plate; but lacks a cover having a flat back side perimeter, a flat generally surrounding cover support zone, a front side having a generally surrounding cover support zone for supporting engagement with the flat back side perimeter of the cover, a center opening extending from the front side through to the back side, the center opening being sized to slidably receive

Art Unit: 2831

the box therethrough, installing the electrical box into the opening in the adapter plate, and securing the cover to the electrical component with the flat back side perimeter of the cover in contact engagement with the cover support zone of the adapter plate.

Hyde (col. 6, lines 1-67) teaches a cover 2 having a flat back side perimeter figure 30, a flat generally surrounding cover support zone 210, a front side having a generally surrounding cover support zone 210 for supporting engagement with the flat back side perimeter of the cover 2, a center opening extending 211 from the front side through to the back side, the center opening 211 being sized to slidably receive the box 10 therethrough, installing the electrical box 10 into the opening 211 in the adapter plate 200, and securing the cover 2 to the electrical component 1 with the flat back side perimeter of the cover 2 in contact engagement with the cover support zone 211 of the adapter plate 200.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Kohnen by providing steps of having a cover having a flat back side perimeter, a flat generally surrounding cover support zone, a front side having a generally surrounding cover support zone for supporting engagement with the flat back side perimeter of the cover, a center opening extending from the front side through to the back side, the center opening being sized to slidably receive the box therethrough, installing the electrical box into the opening in the adapter plate, and securing the cover to the electrical component with the flat back side perimeter of the cover in contact engagement with the cover support zone of the adapter plate in order to secure the cover to the box in view of the teachings of Hyde.

Regarding claim 3, Kohnen (col. 5, line 55 – col. 6, line 67) discloses that the back side of the adapter plate (back side of 38) is formed with a single concave curvature extending generally from top to bottom. See figure 1.

Regarding claim 4, Kohnen (col. 5, line 55 – col. 6, line 67) discloses that the back side of the adapter plate (back side of 38) is formed with a single concave curvature extending generally from top to bottom, but does not disclose a pair of concave curvatures positioned from top to bottom in relation to one another. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a pair concave curvatures positioned from top to bottom in relation to one another, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 5, Kohnen (col. 5, line 55 – col. 6, line 67) discloses the steps of providing that the back side of the adapter plate (back side of 38) is formed with a single concave curvature extending generally from top to bottom. See figure 1.

Regarding claim 6, Kohnen (col. 5, line 55 – col. 6, line 67) discloses the steps of providing that the back side of the adapter plate (back side of 38) is formed with a single concave curvature extending generally from top to bottom, but does not disclose the steps of providing a pair of concave curvatures positioned from top to bottom in relation to one another. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the steps of having a pair concave curvatures positioned from top to bottom in relation to one another, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Art Unit: 2831

Response to Arguments

4. Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anton B Harris whose telephone number is (571) 272-1976. The examiner can normally be reached on weekdays from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Dean Reichard, can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

abh

2/3/06


DEAN A. REICHARD
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